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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,303	07/03/2003	Allan William Timms	30538/38451	4307
4743	7590	12/14/2004	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 6300 SEARS TOWER 233 S. WACKER DRIVE CHICAGO, IL 60606			LAMBKIN, DEBORAH C	
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/613,303	Applicant(s) TIMMS ET AL.	
	Examiner Deborah C Lambkin	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

DEBORAH C. LAMBKIN
PRIMARY EXAMINER

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is no definition for R3. R2 is redundant.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Curtis (4,418,138).

Curtis teaches the basic procedure for preparing thioxanthenes by ring closure condensation between a mercaptobenzoic acid and a substituted phenyl in the presence of sulfuric acid. There is no patentable distinction seen between the prior art process and the instant broad and generic process of claim 1 wherein further the product by process claim is a product claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Curtis (4,418,138) alone or in further view of Shirosaki et al (4,450,279).

Curtis et al teach a genus of thioxanthenes which when (R1)_n is halo, alkyl, alkoxy or dialkylamino, n is 0-2, R2 is alkyl, m is 1 and A is COOH (see col.3), reads on the instant compounds of formula (I) when R1-R3 is H, alkyl, alkoxy, halo or dialkylamino, R4 is O, R6 is alkyl and R5 is H.

Furthermore, Curtis et al teach that thioxanthenes can be prepared by ring closure condensation between thiosalicyclic acid and a substituted phenyl in the presence of sulfuric acid (see example 1).

Shirosaki et al is relied upon to further show that the process for preparing substituted thioxanthenes can be prepared by ring closure condensation between TSA or DTSA and a substituted phenyl in the presence of sulfuric acid wherein the substituents on the phenyl ring do not participate in the reaction and wherein further the mole ratios of the reactants and temperature are within those of the instant claims (see col. 4, lines 39-45 and example 1).

Consequently, it would have been prima facie obvious to one having ordinary skill in the art at the time the application was filed to prepare thioxanthenes by ring closure condensation between TSA or DTSA and the desired substituted phenyl in the

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presence of sulfuric acid and also to choose a species from a prior art genus, motivation being that the process would be expected to produce the desired thioxanthone in good yield and the species would be expected to possess the same or similar properties as their exemplified counterparts, wherein further any modifications to mole ratios, temperatures and general reactions conditions is a routine expedient, all with a reasonable expectation the resultant thioxanthone would be produced in useful yields, absent some unobvious or unexpected results.

No unobvious or unexpected results are seen.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah C Lambkin whose telephone number is 571-272-0698.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699.


DEBORAH C. LAMBKIN
PRIMARY EXAMINER